

PATENT
ATTORNEY DOCKET NO. 07306/013001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Reid *et al.* Art Unit: 1643
Serial No.: 09/129,028 Examiner:
Filed: 8/4/98
Title: METHODS FOR TREATING NEUROLOGICAL DEFICITS

30715 U.S. PTO
09/739933
12/18/00

Assistant Commissioner for Patents
Washington, DC 20231
Box Missing Parts

RECEIVED
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OFFICE OF PETITIONS

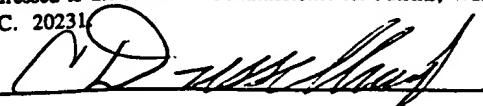
PETITION UNDER RULE 1.47(a)

Pursuant to 37 CFR 1.47(a) and MPEP 409.03, assignee and real-party-in-interest, The Regents of the University of California, and co-inventor James H. Fallon respectfully state that co-inventor James Steven Reid refuses to join the application for patent, and requests that this application be accepted for examination and that the attached declaration be accepted without the signature of one of the co-inventors, Dr. James Steven Reid. The inventor has agreed in writing to assign the invention to The Regents of the University of California. A copy of a Patent Agreement entered into between the University and Dr. Reid as part of his employment is attached hereto. The University has sufficient proprietary interest in the application to justify making application as agent for the inventor.

An appropriate declaration executed by co-inventor James H. Fallon, but with the signature block for Dr. Reid left blank, as permitted by MPEP 409.03(a), is being submitted concurrently herewith in response to the Notice to File Missing Parts.

Dr. Reid was an employee of the University. A copy of a Patent Agreement executed by Dr. Reid, attached hereto, provides in paragraph 4 (page 2) that Dr. Reid agrees "to assign to University all rights, title and interest" in any invention for which the University seeks patent protection. By virtue of this agreement, the University has a proprietary interest in the application to justify making application as agent for the inventor. This action is necessary to preserve the rights of the assignee, The Regents of the University of California. Otherwise, irreparable damage would result since the

05/07/2001 LGIBBS 000 0009 061050 09739933
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Date of Deposit 3-31-99
I hereby certify under 37 CFR 1.8(a) that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage on the date indicated above and is addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.


application could not be properly filed.

A bona fide and successful effort was made to present the application papers, including the specification, drawings, claims and declaration, to Dr. Reid for review and execution. Dr. Reid refuses to execute the papers. These papers, including the specification, drawings, claims and declaration, were mailed to Dr. Reid at his known addresses by a representative of Fish & Richardson, counsel for applicant, on multiple occasions. See Declaration of John R. Wetherell filed herewith.

Dr. Reid's last known address is:

P.O. Box 7683
Berkeley, CA 94707

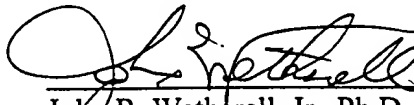
This also is believed to be his current address.

For the foregoing reasons, this application should be accepted for examination under 37 CFR 1.47(a). Kindly accept the filing of the above-referenced application under 1.47(a), and issue a notice of same.

A check for \$130 prescribed under 37 CFR 1.17(h) is included to cover the petition fee. The Commissioner is authorized to apply any uncovered charges, or any credits, to Deposit Account No. 06-1050, Ref. 05491/039001.

Respectfully submitted,

Date: 3/31/89


John R. Wetherell, Jr., Ph.D.
Reg. No. 31,678

Fish & Richardson P.C.
4225 Executive Square, Suite 1400
La Jolla, CA 92037

Telephone: 619/678-5070
Facsimile: 619/678-5099

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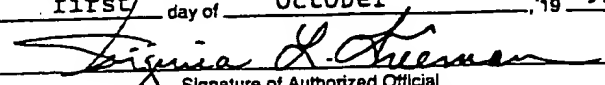


**UNIVERSITY OF CALIFORNIA
STATE OATH of ALLEGIANCE
and
PATENT AGREEMENT**
UPAY 585 (R5/91)

EMPLOYEE'S NAME (Last, first, middle initial)		DATE PREPARED	
Reid, James Steven		TO	DI 93
DEPARTMENT		EMPLOYMENT DATE	
Anatomy & Neurobiology		TO	DI 93

STATE OATH OF ALLEGIANCE

I do solemnly swear (or affirm) that I will support and defend the Constitution of the United States and the Constitution of the State of California against all enemies, foreign and domestic; that I will bear true faith and allegiance to the Constitution of the United States and the Constitution of the State of California; that I take this obligation freely, without any mental reservation or purpose of evasion; and that I will well and faithfully discharge the duties upon which I am about to enter.

Taken and subscribed before me this
first day of October, 19 93

 Signature of Authorized Official
 Administrative Assistant
 Title
Orange CA
 County State

Signature of Officer or Employee (DO NOT Sign Until in The Presence of a Witness)

NOTE: No fee may be charged for administering this oath.

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Oath must be administered by either (1) a person having general authority by law to administer oaths—for example: Notaries Public, Civil Executive Officers (Section 1001 of Government Code), Judicial Officers, Justices of the Peace, and county officials named in Sections 24000, 24057 of Government Code; such as, district attorneys, sheriffs, county clerks, members of boards of supervisors, etc., or (2) by any University Officer or employee who has been authorized in writing by The Regents to administer such oaths.

WHO MUST SIGN THE OATH: All persons (other than aliens) employed by the University, in common with all other California public employees, whether with or without compensation, must sign the Oath. (Calif. Constitution, Article XX, Section 2, Calif. Government Codes, Sections 3100-3102.)

All persons re-employed by the University after a termination of service must sign a new Oath if the date of re-employment is more than one year after the date on which the previous Oath was signed (Calif. Government Code, Section 3102).

WHEN MUST OATH BE SIGNED: The Oath must be signed BEFORE the individual enters upon the duties of employment. (Calif. Constitution, Article XX, Section 3: Calif. Government Code Section 3102.)

WHERE OATHS ARE FILED: The Oaths of all employees of the University shall be filed with the Campus Accounting Office.

FAILURE TO SIGN OATH: No compensation for service performed prior to his subscribing to the Oath or affirmation may be paid to a University employee. And no reimbursement for expenses incurred may be made prior to his subscribing to the Oath or affirmation. (Calif. Government Code, section 3107.)

PENALTIES: "Every person who, while taking and subscribing to the Oath or affirmation required by this chapter, states as true any material which he knows to be false, is guilty of perjury, and is punishable by imprisonment in the state prison not less than one or more than 14 years." (Calif. Government Code, Section 3108.)

UNIVERSITY OF CALIFORNIA PATENT POLICY

I. PREAMBLE

It is the intent of the President of the University of California, in administering intellectual property rights for the public benefit, to encourage and assist members of the faculty, staff, and others associated with the University in the use of the patent system with respect to their discoveries and inventions in a manner that is equitable to all parties involved.

The University recognizes the need for and desirability of encouraging the broad utilization of the results of University research, not only by scholars but also in practical application for the general public benefit, and acknowledges the importance of the patent system in bringing innovative research findings to practical application.

Within the University, innovative research findings often give rise to patentable inventions as fortuitous by-products, even though the research was conducted for the primary purpose of gaining new knowledge.

To encourage the practical application of University research for the broad public benefit, to appraise and determine relative rights and equities of all parties concerned, to facilitate patent applications, licensing, equitable distribution of royalties, if any, to assist in obtaining funds for research, to provide for the use of invention-related income for the further support of research and education, and to provide a uniform procedure in patent matters when the University has a right or equity, the following University of California Patent Policy is adopted.

II. STATEMENT OF POLICY

- A. An agreement to assign inventions and patents to the University, except those resulting from permissible consulting activities without use of University facilities, shall be mandatory for all employees, for persons not employed by the University but who use University research facilities, and for those who receive gift, grant, or contract funds through the University. Exemptions from such agreements to assign may be authorized in those circumstances when the mission of the University is better served by such action, provided that overriding obligations to other parties are met and such exemptions are not inconsistent with other University policies.
- B. Those individuals who have so agreed to assign inventions and patents shall promptly report and fully disclose the conception and/or reduction to practice of potentially patentable inventions to the Director of the Office of Technology Transfer. They shall execute such declarations, assignments, or other documents as may be necessary in the course of invention evaluation, patent prosecution, or protection of patent or analogous property rights, to assure that title in such inventions shall be held by the University or by such other parties designated by the University as may be appropriate under the circumstances. Such circumstances would include, but not be limited to, those situations when there are overriding patent obligations of the

University arising from gifts, grants, contracts, or other agreements with outside organizations.

In the absence of overriding obligations to outside sponsors of research, the University may release patent rights to the inventor in those circumstances when:

- (1) the University elects not to file a patent application and the inventor is prepared to do so, or
- (2) the equity of the situation clearly indicates such release should be given, provided in either case that no further research or development to develop that invention will be conducted involving University support or facilities, and provided further that a shop right is granted to the University.

- C. Subject to restrictions arising from overriding obligations of the University pursuant to gifts, grants, contracts, or other agreements with outside organizations, the University agrees, for and in consideration of said assignment of patent rights, to pay annually to the named inventor(s), or to the inventor(s)' heirs, successors, or assigns, 50% of the first \$100,000 of cumulative net royalties and fees per invention received by the University, 35% of the next \$400,000 of cumulative net royalties and fees per invention received by the University, and 20% of all additional cumulative

net royalties and fees per invention received by the University. Net royalties are defined as gross royalties and fees, less 15% thereof for administrative costs, and less the costs of patenting, protecting, and preserving patent rights, maintaining patents, the licensing of patent and related property rights, and such other costs, taxes or reimbursements as may be necessary or required by law.

When there are two or more inventors, each inventor shall share equally in the inventor's share of royalties, unless all inventors previously have agreed in writing to

a different distribution of such share.

Distribution of the inventor's share shall be made annually in February from the amount received during the penultimate calendar year. In the event of any litigation, actual or imminent, or any other action to protect patent rights, the University may withhold distribution and impound royalties until resolution of the matter.

D. In the disposition of any net income accruing to the University from patents, first consideration shall be given to the support of research.

III. PATENT RESPONSIBILITIES AND ADMINISTRATION

A. Pursuant to Standing Order 100.4(gg), the President has responsibility for all matters relating to patents in which the University of California is in any way concerned.

B. The President is advised on such matters by the Intellectual Property Advisory Council (IPAC), which is chaired by the Senior Vice President—Academic Affairs. The membership of IPAC includes representatives from campuses, Agriculture and Natural Resources, the Department of Energy Laboratories, and the Director of the Office of Technology Transfer. IPAC is responsible for:

1. reviewing and proposing University policy on intellectual property matters including patents, copyrights, trademarks, and tangible research products;
2. reviewing proposed exceptions to established policies; and
3. advising the President on related matters as requested.

C. The Senior Vice President—Administration is responsible for implementation of this Policy, including the following:

1. Evaluating inventions and discoveries for patentability, as well as scientific, merit and practical application, and requesting the filing and prosecution of patent applications.

2. Evaluating the patent or analogous property rights or equities held by the University in an invention, and negotiating agreements with cooperating organizations, if any, with respect to such rights or equities.

3. Negotiating licenses and license option agreements with other parties concerning patent and/or analogous property rights held by the University.

4. Directing and arranging for the collection and appropriate distribution of royalties and fees.

5. Assisting University officers in negotiating agreements with cooperating organizations concerning prospective rights to patentable inventions or discoveries made as a result of research carried out under grants, contracts, or other agreements to be funded in whole or in part by such cooperating organizations, and negotiating with Federal agencies regarding the disposition of patent rights.

6. Recommending to the President appropriate action on exemptions from the agreement to assign inventions and patents to the University as required by Section II, A., above.

Revised April 16, 1990

PATENT AGREEMENT

(Please read Patent Policy on reverse side and above.)

This agreement is made by me with The Regents of the University of California, a corporation, hereinafter called "University," in part consideration of my employment, and of wages and/or salary to be paid to me during any period of my employment, by University, and/or my utilization of University research facilities and/or my receipt of gift, grant, or contract research funds through the University.

By execution of this agreement I understand that I am not waiving any rights to a percentage of royalty payments received by University, as set forth in University Patent Policy, hereinafter called "Policy." I also understand and agree that the University has the right to change the Policy at any time, including the percentage of net royalty payments paid to me.

I agree that every possibly patentable device, process, plant, or product, hereinafter referred to as "invention," which I conceive or develop while employed by University, or during the course of my utilization of any University research facilities or any connection with my use of gift, grant, or contract research funds received through the University, shall be examined by University to determine rights and equities therein in accordance with the Policy, and I shall promptly furnish University with complete information with respect to each.

In the event any such invention shall be deemed by University to be patentable, and University desires, pursuant to determination by University as to its rights and equities therein, to seek patent protection thereon, I shall execute any documents and do all things necessary, at University's expense, to assign to University all rights, title and interest therein and to assist University in securing patent protection thereon. The scope of this provision is limited by California Labor Code section 2870, to which notice is given below. In the event I protest the University's determination regarding any rights or interest in an invention, I agree: (a) to proceed with any University requested assignment or assistance; (b) to give University notice of that protest no later than the execution date of any of the above-described documents or assignment; and (c) to reimburse University for all expenses and costs it encounters in its patent application attempts, if any such protest is subsequently sustained or agreed to.

I shall do all things necessary to enable University to perform its obligations to grantors of funds for research or contracting agencies as said obligations have been undertaken by University.

University may relinquish to me all or a part of its right to any such invention, if, in its judgment, the criteria set forth in the Policy have been met.

I agree to be bound hereunder for and during any periods of employment by University or for any period during which I conceive or develop any invention during the course of my utilization of any University research facilities, or any gift, grant, or contract research funds received through the University.

In signing this agreement I understand that the law, of which notification is given below, applies to me, that I am still required to disclose all my inventions to the University.

NOTICE

This agreement does not apply to an invention which qualifies under the provisions of Labor Code section 2870 of the State of California which provides that (a) Any provisions in an employment agreement which provides that an employee shall assign, or offer to assign, any of his or her rights in an invention to his or her employer shall not apply to an invention that the employee developed entirely on his or her own time without using the employer's equipment, supplies, facilities, or trade secret information except for those inventions that either: (1) Relate at the time of conception or reduction to practice of the invention to the employer's business, or actual or demonstrably anticipated research or development of the employer; (2) Result from any work performed by the employee for the employer; (b) To the extent a provision in an employment agreement purports to require an employee to assign an invention otherwise excluded from being required to be assigned under subdivision (a), the provision is against the public policy of this state and is unenforceable.

In any suit or action arising under this law the burden of proof shall be on the individual claiming the benefits of its provisions.

Employee/Guest Name James Steven Reid Witness Signature [Signature] Date: 10/01/93
(Please Print)
Employee/Guest Signature: [Signature] Date: 10/01/93
(Please complete withholding certificate and State Oath, also.)

RETN: ACCOUNTING—5 yrs. after separation, except in cases of disability, retirement or disciplinary action, in which cases retain until age 70.
Other Copies: 0—5 years after separation.

ATTACH TO PERSONNEL ACTION FORM (UPAY 560)